

## **REMARKS**

In the Office Action mailed March 20, 2008, the Examiner noted that claims 1-3, 7 and 12-25 were pending. Claim 20 has been amended. In view of the forgoing claims 1-3, 7 and 12-25 remain pending for which reconsideration is requested. No new matter has been added.

### **Rejection under 35 U.S.C. § 101**

On page 2, the Office Action rejected claims 20-22 under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Claim 20 has been amended to recite "a menu selection system, comprising: a display displaying: a radial portion...and a linear portion." Accordingly, Applicants submit that claim 20 is directed to statutory subject matter and request the rejection be withdrawn for claim 20 and dependent claims 21 and 22.

### **Summary of Examiner Interview and Response to Examiner Arguments**

Applicants thank the Examiner for conducting an in-person Examiner Interview on July 9, 2008. During the Interview, Applicants' representatives discussed how the June 4, 2007 Declaration and Attachments filed on June 11, 2007, establish invention of the present application prior to the effective date of the Smith reference (i.e. April 28, 1995). The points discussed during the Interview are further elaborated on below. Favorable consideration in view of the Interview and remarks below is respectfully requested.

On page 3 of the Office Action, the Examiner rejected all claims under 35 U.S.C. § 102 as anticipated by Smith. As evidenced by the Declaration executed on June 4, 2007, Smith is not prior art. The final Office Action disputes the adequacy of the evidence submitted, however, and states that the June 4, 2007 Declaration and Attachments filed on June 11, 2007 "have been considered but they are ineffective to overcome the applied reference[]" (page 3, numbered paragraph 1). Briefly, the final Office Action alleged the following three deficiencies in the June 4, 2007 Declaration and Attachments: (1) the evidence submitted was deemed insufficient to establish conception, (2) the evidence submitted was deemed insufficient to show due diligence and (3) the evidence submitted was deemed insufficient to shown the applicant was in possession of all the limitations prior to April 25, 1995. Each allegation in the final Office Action is traversed in turn below. Reconsideration is respectfully requested.

On page 7 the Office Action alleges, with reference to numbered paragraph 2 in the June 4, 2007 Declaration, that "this concept was only implemented on a single (or local) computer" (lines 13-14) and based on this assertion, the final Office Action concludes "the Applicant did not

know how to make the concept working [sic] as claimed 'a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location'"(lines 15-16).

This analysis of the June 4, 2007 Declaration presented in the final Office Action had two principal shortcomings: the June 4, 2007 Declaration did not state or suggest "this concept was only implemented on a single (or local) computer", as asserted by the final Office Action; and the final Office Action does not provide any evidence supporting its conclusion that the claimed "pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location" was unsupported by the June 4, 1995 Declaration. To emphasize this point, numbered paragraph 2 from the June 4, 2007 Declaration is reproduced below, in its entirety:

Prior to March 9, 1995 I conceived of a menu selection system including a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion where a pointing device is used for indicating a type of selection by making a stroke or mark with a direction and designating a location and including a computer connected to the display and the pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the stroke or location. On or about March 9, 1995 I documented this conception in my hardbound notebook as shown in Attachment A.

(emphasis added). As shown above, the Declaration includes the explicit statement "Prior to March 9, 1995 I conceived ... a pointing device is used for indicating a type of selection by making a stroke or mark with a direction and designating a location" made in the signed June 4, 1995 Declaration.

Moreover, the above assertions made in the Declaration are supported by at least Attachments A and B (see for example, pages 1 and 2 of Attachment A, and page 2, third paragraph of the "Introduction" section of Attachment B).

In light of the statements made by the inventor and supporting Attachments, it is submitted that the evidence filed on June 11, 2007, establishes conception prior to April 25, 1995.

On page 7 the Office Action concludes that "the evidence submitted is also insufficient to establish due diligence from a date prior to the date of reduction to practice of Smith and to either a constructive reduction or an actual reduction to practice" (lines 17-19) and specifically alleged of "periods of lacking activity in the Attachments without any explanation such as periods of 2 months between April 28, 1995 and June 6, 1995" (page 6, lines 16-18), presumably as the rationale for its conclusion. This assertion is respectfully traversed, and Examiner's attention is

directed to numbered paragraph 2, which describes activity prior to April 25, 1995 (the Smith reduction to practice date) while numbered paragraphs 4-7 described activity after April 25, 1995 but prior to June 6, 1995. These statements by the inventor are supported by the work reports of Mr. Beckers, submitted as Attachment D on June 11, 2007.

Therefore, in light of the statements made in by the inventor and submitted documentation, it is submitted that the evidence filed on June 11, 2007 shows due diligence prior to April 25, 1995, and from April 25, 1995 to June 6, 1995.

On page 9 the Office Action concludes that

there is not [*sic*] explanation of the exhibits or positive statement on the declaration to support the limitation "a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location; and a computer connected to said display and said pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the one of the stroke and the location."

In response, the Examiner is urged to review numbered paragraph 2 from the June 4, 2007 Declaration, which positively states on lines 1-6 what the final Office Action alleged was absent.

Therefore, in light of the statements made by the inventor, the conclusion made by the Office Action, namely that the evidence submitted was deemed insufficient to shown the applicant was in possession of all the limitations prior to April 25, 1995, was not warranted and it is submitted that the evidence filed on June 11, 2007 does indeed show possession of all the claimed limitations.

Moreover, even if Smith were taken as prior art, the Office Action failed to provide *prima facie* evidence that Smith anticipates the pending claims. In rejecting the claims under section 102, the Examiner conceded Smith failed to "teach two different portions of radial marking menu and linear menu" (page 3, lines 11-12) and merely stated "it was well known in the computer arts to implement the two different menu portions" (page 3, lines 12-13). The final Office Action, however, failed to adequately provide any evidence of common knowledge. As stated in section 2144.03 of the Manual of Patent Examining Procedure, the when Official Notice is taken that is unsupported by documentary evidence, the "examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge" (*citing Soli*, 317 F.2d 941, 946, 37 USPQ 797, 801 (CCPA 1963) and *Chevenard*, 139 F.2d 711, 713, 60 USPQ, 239, 241 (CCPA 1943)).

Since the Office Action failed to "provide specific factual findings predicated on sound technical and scientific reasoning", but merely asserts "it was well known in the computer arts to implement the two different menu portions", it is submitted that the Office Action has *not* adequately demonstrated that Smith anticipates the pending claims because Smith fails to teach two different portions of radial marking menu and linear menu.

Therefore, Applicants submit that Smith is not prior art and request the rejection be withdrawn.

### Conclusion

It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: \_\_\_\_\_

7/21/08

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